

REMARKS

Claims 11-27 are pending.

Claims 11, 13, 14, 20, 21, 23 and 27 are independent claims.

A letter regarding an incomplete Office Action was submitted on July 13, 2004. As the Patent Office has not responded to this letter the following request for reconsideration is made in order to expedite prosecution.

Foreign Priority

The Examiner did indicate that the certified copies were received in a national stage application from the International Bureau.

Drawings

The Examiner indicated that the drawings as filed have been accepted.

Reply to Rejections

First Rejection

Claims 11, 12 and 14-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Publication No. 2002/0196364 to Hendricks in view of U. S. Publication No. 2002/0002466 to Kambayashi et al (hereinafter "Kambayashi"). This rejection is traversed.

Initially, the publication to Hendricks has a filing date of September 28, 2001, which is after the filing date of the present application. It is noted that in Hendricks there is a line of continuing applications, (Divisionals) including No. 08/336,247, filed on November 7, 1994, now Patent No. 5,986,690. As the undersigned became aware of Patent No. 5,986,690, the rejection will be treated based on the common disclosure of that patent. The Examiner may wish to clarify this point.

Also, while the Kambayashi reference also has a publication date after the filing date of the present application, it is a CPA of an application filed May 13, 1998, which is its effective date.

In rejecting the claims based on Hendricks, the Examiner relies on paragraphs 0085-0088, 0069 and 0056. These paragraphs are also found in Patent No. 5,986,690 in column 11, lines 8-30, column 8, lines 61 to column 9, line 11, and column 6, line 61 to column 7, line 11.

In rejecting the claims based on Hendricks, it was asserted that Hendricks discloses certain elements as set forth in Section 5 of the Office Action, lines 4-10. But it is not clear from the various portions of Hendricks relied on that Hendricks does disclose, for example, "the content of an electronic book selected by said user interface."

In any case, the Examiner does at least recognize that Hendricks does not expressly disclose "a processing unit extracting from said storage unit a contents identifier corresponding to the contents selected by said user interface... electronic book selected by said user interface," (claim 11). The Examiner then relies on paragraph 0413 of Kambayashi to show this deficiency in the rejection based on Hendricks. But paragraph 0413 (column 6, line 61 to column 7 line 11 of the patent) of Kambayashi states as follows:

"In this case, the encrypted portion of the license information has been encrypted using a secret key ks (the secret key ks is commonly used for all decoder units D). The decoder section **2002** receives the secret key ks from the decoding key generation section **2041** and decodes the encrypted portion (step **S1072**). The contents ID is extracted from the decoded portion of the license information (step **S1073**)."

Actually, Kambayashi does not show a processing unit extracting from said storage unit a contents identifier

corresponding to the contents selected by said user interface...electronic book selected by said user interface. While the Examiner asserts that this would have been obvious to one skilled in the art based on the disclosure of Kambayashi in paragraph 0005, actually this is just a brief summary of the Kambayashi invention, and it would not provide the motivation to modify Hendricks as asserted.

Also, Kambayashi is not analogous to Hendricks because Hendricks is involved with electronic book selection and delivery system while Kambayashi is directed to an information recording apparatus for recording information on a recording medium, such as a DVD. Kambayashi and Hendricks are not in the same field of endeavor, and furthermore, one skilled in the art seeking to solve an asserted problem for Hendricks would not consider a DVD recording device to solve a problem in electronic book selection. See *In re Wood and Eversole*, 202 USPQ 171, 174 (CCPA 1974), which states as follows:

"Nonanalogous Art

[2] In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. ... The rationale behind this rule precluding

rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

[3] The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." (Underline added.)

With respect to the rejection of independent claim 14, the Examiner again relies on paragraph 0366 of Kambayashi and paragraph 0020 of Kambayashi. It is submitted that these portions of Kambayashi do not cure the innate deficiencies of the rejection based on Hendricks.

With respect to the dependent claims that have been rejected, these claims are considered patentable at least for the same reasons as their base or intervening claims.

It appears that the Examiner has concentrated on the obviousness of substitutions and not the combination as a whole, as required by 35 U.S.C. § 103. See *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986), wherein the Court stated as follows:

"Focusing on the obviousness of substitution and the differences instead of the invention as a whole ... was a legally improper way to simplify the difficult determination of obviousness."

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Second Rejection

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of U. S. Publication No. 2003/0191719 to Ginter et al. (hereinafter "Ginter"). This rejection is traversed.

The Ginter publication has a filing date of December 21, 2001.

A translated copy of Applicants' foreign priority Nos. 10-187056 and 10-187057, which establishes a date of July 2, 1998 was previously submitted. Accordingly, Ginter is not a viable reference based on its date.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claim under 35 U.S.C. § 103.

Third Rejection

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks and Kambayashi in view of Ginter. This rejection is traversed.

As explained in the reply to the rejection of claim 13, the foreign priority documents establish a date before Ginter. Accordingly, a rejection based on Ginter is not viable.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claim under 35 U.S.C. § 103.

Fourth Rejection

Claims 21, 23 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks. This rejection is traversed.

The asserted reasons for this rejection are, for example, are as follows:

"At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to develop a system that generates and adds to electronic book data auxiliary information according to the electronic book data and an input user identifier. One of ordinary skill in the art would have been motivated to do this because it eliminates the distribution of any physical object such as a paper book (see paragraph [0004])."

With respect to claim 27, the Examiner asserts as follows:

"At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to develop a apparatus comprising discloses contents including a plurality of modules with at least one of data and processing program and a module with a description of display attribute information, a processing unit extracting a display attribute from said module with a description of a display attribute, and selectively executing said plurality of modules according to said display attribute to reproduce and contents and display unit displaying contents reproduced by said processing unit."

The Examiner's rejection of what one skilled in the art including claims 21 and 23 would do is truly speculation. Speculation is not viable evidence to reject claims under 35 U.S.C. § 103. See *In re Jones*, 21 USPQ 1941, 1944 (Fed. Cir. 1992) (also cited in the MPEP), wherein the Court stated as follows:

"Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the ... art would have been motivated to make the modifications of the prior art ('The prior art must provide one of ordinary skill in the art the motivation')"

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Fifth Rejection

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks as applied to claim 21 above, and further in view of U. S. Patent No. 6,073,122 to Wool. This rejection is traversed.

As explained *supra*, Hendricks does not suggest the structure of claim 21. The addition of Wool does not cure the inherent deficiencies of a rejection based on Hendricks.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claim under 35 U.S.C. § 103.

Sixth Rejection

Claims 24 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks as applied to claim 23 above, and further in view of Ginter. This rejection is traversed.

The Ginter reference is no longer a viable reference as the foreign priority documents establish a date before Ginter. See *supra*.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Seventh Rejection

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks as applied to claim 23 above, and further in view of Kambayashi. This rejection is traversed.

In the first instance, as explained *supra* in the reply to the rejection of claim 23, Hendricks does not suggest the features of the claim 23. Claim 25 is a dependent claim. Additionally, it is the Examiner's position that the motivation to change Hendricks from Kambayashi is found in paragraph 0005. But what Kambayashi is discussing is an improvement of his device, and this would not be motivation to modify Hendricks. Also, as noted above, the two references are non-analogous.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claim under 35 U.S.C. § 103.

Summary

In summary, the rejections applied do not establish a *prima facie* case of obviousness. First, as noted above, some of the art applied is not analogous. Also, the Examiner has merely picked bits and pieces of the references and concentrated on the obviousness of substitutions and not the combination as a whole, as required by 35 U.S.C. § 103. Even if the references show what has

been claimed, which they do not, there is no valid motivating reason to combine the teachings of the references without hindsight reconstruction based on the Applicants' disclosure.

Also, even if the references showed all the elements, which they do not, it is the combination that counts. See *Ruben Condenser Co. v. Copeland and Refrigeration Corp.* 31 USPQ 6, 6 (C.A.2 1936) which states "We do not of course forget that it is always the combination that counts, and that no patents, or almost none, are made from new elements. But all combinations are not patentable combinations."

In section 2 of the Office Action, the Examiner responded to arguments, a reply to this response is as follows:

The response in paragraphs 3 and 4 has been treated in the reply to the rejections.

In section 5 the Examiner responds to the statement that the art applied (*Kambayashi et al.*) is not analogous art. The Examiner relies on *In re Oetiker*, 977, F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Actually, the *Oetiker* case stood for the proposition that the art applied was not analogous and for the reasons set forth in the reply to the rejection *Hendricks and Kambayashi et al.* are not analogous.

In section 6 the Examiner states that *Ginter et al* claims benefit of application no. 09/272,998 filed on March 19, 1999. But

Ginter identifies this application as a continuation in part. Also the Examiner does not identify that the matter in the Ginter publication was present in the continuation in part of application. Also the date March 19, 1999 in any case would be overcome by the foreign priority document that has a date of July 2, 1998.

It is noted that in the second paragraph regarding application data Ginter et al. discloses continuation applications that include Patent No. 6,292,569 and Patent No. 6,157,721. For the record it is noted that the Examiner correctly did not rely on these patents. It will be noted that the Ginter publication to the 2003/019171981 has over 49 pages of disclosure while these two patents have 22 and 26 pages of the disclosure. Certainly this is circumstantial evidence that the publication of Ginter at best is a CIP of the two cited patents.

Also in section 7 with respect to motivation the Examiner states that modifying Hendricks to include the features of Kambayshi et al. will less provide a quick and easy distribution and copyright protection. It is noted that there is no disclosed problem in the Hendricks regarding copyright protection. The Examiner's Statement is without any evidence support. Also the two cases cited by the Examiner in section 7 of the Office Action, actually establish that the motivation was not present in the facts of those two cases.

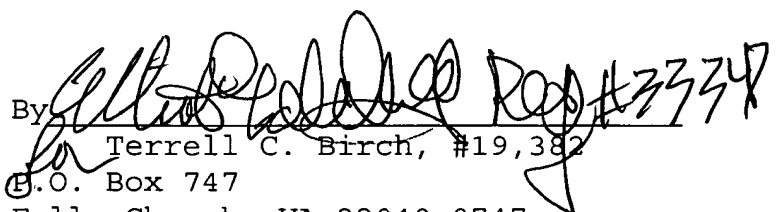
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347), at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  Reg #33347
Terrell C. Birch, #19,382
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

TCB/EAG/slb/mlr/fjl